C. REMARKS

This Reply is in response to the Office Action mailed on February 26, 2003 in which claims 1-18 and 44-50 were rejected. With this Reply, claim 13 is amended. Claims 1-18 and 44-50 are presented by the Applicants for reconsideration and allowance.

1. *REJECTION OF CLAIMS 1-18 AND 44-50 UNDER 35 U.S.C. § 103(a) AS BEING UNPATENTABLE OVER NAKANISHI ET AL. IN VIEW OF AIZAWA*

Section 1 of the Office Action rejected claims 1-18 and 44-50 under 35 U.S.C. § 103(a) as being unpatentable over Nakanishi et al. (U.S. Patent No. 4,928,972) in view of Aizawa (U.S. Patent No. 5,697,855). Claims 1, 13 and 44 are independent claims, and claims 2-12, 14-18 and 45-50 depend from claims 1, 13 and 44, respectively.

Claims 1-12 and 44-50:

Independent claim 1 recites a golf club head including a front wall, a sole portion and a resilient insert assembly. The front wall includes a rearwardly sloped front strike side and a rear side. The rear side has an upper region and a lower region. The sole portion rearwardly extends from the lower region of the rear side. The rear side and the sole portion define a forwardly extending cavity and a recess. The recess downwardly extends into the sole portion and interconnects with the cavity. The insert assembly is positioned in and substantially fills the recess. The insert assembly is coupled to at least the sole portion or the lower region of the rear side. The upper region of the rear side is generally uncovered. The insert assembly is fabricated of at least one material. The material has a durometer of between 20 on a Shore A hardness scale and 75 on a Shore D hardness scale.

Independent claim 44 recites a golf club head including a front wall, a sole portion and a resilient insert assembly. The front wall includes a rearwardly sloped front strike side and a rear side, wherein the rear side has an upper region and a lower region. The sole portion rearwardly extends from the lower region of the rear side. The sole portion

includes an upwardly extending rear wall. The rear side defines a forwardly extending cavity. The lower region of the rear side, the rear wall of the sole portion and the sole portion define a recess. The recess is interconnected with the cavity and is open only in an upward direction. The resilient insert assembly is positioned in and substantially fills the recess. The insert assembly is coupled to at least one of the sole portion and the lower region of the rear side. The upper region of the rear side is generally uncovered.

It is respectfully submitted that claims 1 and 44 are patentable over Nakanishi et al. and Aizawa, because neither Nakanishi et al. nor Aizawa, alone or in combination, teach, suggest or disclose the combination of elements and limitations of either independent claim 1 or 44. In particular, neither Nakanishi et al. nor Aizawa teach, suggest or disclose a golf club head including a front wall with a rear side, wherein the rear side has an upper region and a lower region, a sole portion rearwardly extending from the lower region, wherein the rear side defines a forwardly extending cavity and the rear side and the sole portion define a downwardly extending recess interconnected with the cavity, and a resilient insert assembly positioned in and substantially filling the recess, wherein the upper region of the rear side is generally uncovered.

In contrast to limitations of claims 1 and 44, Nakanishi et al. discloses an iron club head having a shooting face and a sole face. A recess is formed into the rear side of the shooting face. In one embodiment, an upwardly extending rise is formed near the rear of the shooting face. Nakanishi et al. further discloses a fiber reinforcement placed in the recess to substantially cover the entire rear side of the shooting face. Next, a crude synthetic resin backup is also placed into the recess to fully cover and lock the fiber reinforcement in place against the rear side of the shooting face. In one embodiment, the fiber reinforcement in addition to substantially covering the rear side of the shooting face is also hollow in construction. In another embodiment, the rear side of the shooting face is substantially covered by a layer of bonding tape, then a back insert formed of several layers of chip-like carbon or aramide fibers is placed over and substantially covers the layer of bonding tape.

Next, a layer of double bonding tape is applied over the back insert to help maintain the insert in place prior to the introduction of the epoxy resin material, which also substantially covers the back insert as well as the layer of double bonding tape.

In every embodiment of Nakanishi et al., substantially the entire rear side of the shooting face is covered by at least two different layers of different materials. In fact, Nakanishi et al. discloses at least six separate embodiments and every embodiment includes at least a fiber reinforcement member and a layer of crude synthetic resin covering substantially the entire rear side of the shooting face. Nakanishi et al. is wholly devoid of any teaching, disclosure or suggestion of leaving an upper region of the rear side of the shooting face uncovered by a reinforcement member or by a layer of crude synthetic resin.

Aizawa discloses a golf club head including a head body of an iron club and a face plate. The head body includes a sole portion, a face portion, and a back portion with a through hole formed through the face portion and extending to the back portion. The face portion includes a peripheral recess for receiving the face plate, which covers the forward side of the through hole. Aizawa further discloses the placement of one or two circular vibration-absorbing members onto the back surface of the face plate. Aizawa specifically teaches that "[t]he vibration-absorbing member 41 is so sized that it , when mounted on the back surface of the face plate 35, will not contact the peripheral portion at the back portion of the head body." Col. 4, lines 3-6. Aizawa further teaches that when a single vibration-absorbing member is used, it is to located only on the back surface of the face plate at the location of the sweet spot. Alternatively, when two vibration-absorbing members are used, they are to be spaced apart such that the location of the sweet spot is between the vibration-absorbing members.

Aizawa does not disclose a forwardly extending cavity interconnected with a downwardly extending recess. In addition to not disclosing, teaching or suggesting a club head body with a cavity and a recess, Aizawa does not disclose, teach or suggest a resilient insert substantially filling a recess. Aizawa teaches and discloses only very specific placement

locations for the circular vibration-absorbing members. The locations of the circular vibration-absorbing members taught and disclosed by Aizawa necessarily require the circular vibration-absorbing member(s) to be positioned on, and to cover, at least a portion of the upper region of the back surface of the face plate.

Accordingly, neither Nakanishi et al. nor Aizawa, alone or in combination, teach, suggest or disclose a resilient insert assembly positioned in and substantially filling a downwardly extending recess and an upper region of the rear side of the front wall of the club head being generally uncovered. Nakanishi et al. teaches and discloses a fiber reinforcement member and a layer of synthetic resin substantially covering the entire rear side of the shooting face of the club head, and Aizawa discloses circular vibration-absorbing elements located at, or spaced about the sweet spot of the face plate such that at least a portion of the vibration-absorbing members are positioned in the upper region of the back surface of the face plate.

Further, it is respectfully submitted that the combinations of elements of claims 1 and 44, and, in particular, the limitation requiring the upper region of the rear side of the front wall of the club head to be uncovered, is a significant, nonobvious feature of the claimed invention. Covering the upper region of a rear surface of the front wall of a club head can significantly and negatively affect the performance of the club head. In particular, covering the upper region of the rear side of the front wall can result in a significant deadening and a significant change to the feel of the club head. Such a club head can significantly reduce the feedback felt by the user during play. Moreover, a club head with the substantially the entire rear side of the front wall covered by one or more inserts or layers of material can produce an undesireable, deadened sound during use. Further, placement of layers of material or inserts on the upper and central regions of the rear side of the front wall unnecessarily results in additional weight at the center of the club head, which undesirably decreases the perimeter weighting of the clubhead and undesirably raises the center of gravity of the club head. Accordingly, requiring the upper region of the rear side of the front wall of a club head to be

uncovered is an important performance enhancing non-obvious feature of the claimed invention.

Moreover, it is respectfully submitted that claims 1 and 44 are allowable over Nakanishi et al. and Aizawa, either alone or in combination, because there is no suggestion to combine these references. "The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination." MPEP §2141.01 (*citing Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)). Here, neither Nakanishi et al. nor Aizawa include any suggestion to combine the club head configuration of Nakanishi et al. and the vibration-absorbing elements of Aizawa. Moreover, even if Nakanishi et al. and Aizawa were combined, such a combination would not result in the combination of elements and limitations of either claim 1 or claim 44. Only by combining and significantly modifying the teachings of Nakanishi et al. and Aizawa can a combination be attained. Importantly, neither Nakanishi et al. nor Aizawa include any suggestion or teaching as to how such a combination could made and modified in order to achieve the limitations of claims 1 or 44.

In contrast, Aizawa teaches away from such a combination and/or modification by emphasizing and specifically teaching that the vibration-absorbing members should not contact the peripheral portion of the head body. Aizawa teaches away from positioning the vibration-absorbing members so as to substantially fill a recess downwardly extending into the sole portion of a club head, wherein the insert assembly is coupled to at least one of the sole portion and the lower region of the rear side of the front wall of the club head. Aizawa further emphasizes the placement of the vibration-absorbing members at the sweet spot, or alternatively spaced apart, such that the sweet spot is positioned between the vibration-absorbing members. Such placements of the vibration-absorbing members necessarily require

at least a portion of the vibration-absorbing member to be positioned on the upper region of the rear side of the front wall of a club head.

Nakanishi et al., while disclosing several club head configurations and several configurations of fiber reinforcement members, layers of synthetic resin and layers of taping, fails to teach, suggest or disclose an upper region of the rear side of the front wall of a club head that is uncovered by an insert assembly. Nakanishi et al. provides no motivation to proceed with such a modification.

Further, "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." MPEP § 2141.01 (*citing Hodosh* 786 F.2d at 1143). Without the benefit of impermissible hindsight, Applicants respectfully submit that no suggestion exists to combine and modify Nakanishi et al. and Aizawa in order to obtain the combination of elements and limitations of claims 1 or 44.

Accordingly, Applicants respectfully submit that independent claims 1 and 44 are patentable over Nakanishi et al. and Aizawa. Additionally, Applicants respectfully submit that claims 2-12 and 45-50, which depend from independent claims 1 and 44, respectively, are also patentable over Nakanishi et al. and Aizawa for at least the same reasons.

Claims 13-18:

With this Reply, claim 13 is amended to more clearly set forth the invention and is now believed to be patentably distinguishable over the cited prior art. Independent claim 13, as amended, recites a golf club head including a front wall, a sole portion, a first insert and a second insert. The front wall includes a rearwardly sloped front strike side and a rear side. The sole portion rearwardly extends from a lower region of the rear side. The rear side and the sole portion define a forwardly extending cavity and a recess. The recess downwardly extends into the sole portion and interconnects with the cavity. The second insert contacts the first insert. The first and second inserts are positioned only in and collectively substantially fill

the recess. At least one of the first and second inserts is attached to at least one of the sole portion and the lower region of the rear side. The first and second inserts are made of first and second elastomeric materials.

It is respectfully submitted that claim 13 is patentable over Nakanishi et al. and Aizawa, because neither Nakanishi et al. nor Aizawa, alone or in combination, teach, suggest or disclose the combination of elements and limitations of independent claim 13. In particular, neither Nakanishi et al. nor Aizawa teach, suggest or disclose a golf club head including a front wall with a rear side, a sole portion rearwardly extending from a lower region of the rear side, wherein the rear side and the sole portion define a forwardly extending cavity interconnected with a downwardly extending recess, and first insert contacting a second insert, wherein the first and second inserts are positioned only in, and substantially fill, the recess.

As discussed above, Nakanishi et al. teaches and discloses a fiber reinforcement member and a layer of synthetic resin substantially covering the entire rear side of the shooting face of the club head, and Aizawa discloses circular vibration-absorbing elements located at the sweet spot of the face plate, or in spaced apart locations, such that the sweet spot is positioned between the vibration-absorbing members. Such require at least a portion of the vibration-absorbing members to be positioned in the upper region of the back surface of the face plate. The fiber reinforcement member, the layer of synthetic resin and the layers of taping of Nakanishi et al. are not positioned only in a downwardly extending recess in the sole portion of the club head. Rather, Nakanishi et al. exclusively teaches the positioning of the members and layers across the entire rear side of the shooting surface of the club head.

Further, Nakanishi et al. does not teach, suggest or disclose first and second inserts substantially filling a downwardly extending recess in the sole portion of the club head. Nakanishi et al. discloses numerous embodiments, but none of the embodiments or teachings of Nakanishi et al. illustrate, disclose or teach first and second inserts substantially filling a recess. Many of the embodiments of Nakanishi et al. do not include club heads with a

downwardly extending recess. In those embodiments with a downwardly extending recess, the recess is not substantially filled by first and second inserts. Rather, Nakanishi et al. discloses an undercut recess filled by a single insert material, a recess including a hollow fiber reinforcement member that does not fill the recess, and a recess filled with four or more separate inserts including multiple layers of tape, a back insert, a back plate and an epoxy resin backup.

Aizawa does not teach or disclose a club head having a downwardly extending recess. Aizawa also does not teach, suggest or disclose first and second inserts in contact with each other. In contrast, Aizawa teaches away from first and second inserts in contact by specifically stating that the circular vibration-absorbing elements are to be spaced apart about the location of the sweet spot on the rear surface of the face plate such that the sweet spot is between the two circular vibration-absorbing members. Aizawa as stated above also specifically teaches away from contact of the vibration-absorbing element with the peripheral portion of the club head. Aizawa also doesn't disclose first and second inserts positioned only in a recess at the lower region of the rear surface of the front wall of the club head.

Moreover, it is respectfully submitted that claim 13 is allowable over Nakanishi et al. and Aizawa, either alone or in combination, because there is no suggestion to combine these references. The discussion regarding the lack of a suggestion to combine and modify Nakanishi et al. and Aizawa in reference to claims 1 and 44, is also directly applicable to the combination of elements and limitations of claim 13.

Accordingly, Applicants respectfully submit that independent claim 13 is patentable over Nakanishi et al. and Aizawa. Additionally, Applicants respectfully submit that claims 14-18, which depend from independent claim 13, respectively, are also patentable over Nakanishi et al. and Aizawa for at least the same reasons.

2. *CONCLUSION*

Applicants respectfully request reconsideration of claims 1-18 and 44-50 for the reasons stated above. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration under 37 C.F.R. § 1.112 is respectfully requested. The Examiner is invited to telephone the undersigned at (847) 472-6104 to discuss any issues in this case in order to advance the prosecution thereof.

Respectfully submitted,

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By _____

Terence P. O'Brien
Attorney for Applicants
Registration No. 43,840

Wilson Sporting Goods Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

Telephone: (847) 472-6104
(773) 714-6498

Facsimile: (773) 714-4557